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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,063	02/25/2004	Tomohisa Higuchi	249256US6X	8923
22850	7590	04/04/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WALTER, CRAIG E	
			ART UNIT	PAPER NUMBER
			2188	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/785,063	Applicant(s) HIGUCHI, TOMOHISA	
	Examiner Craig E. Walter	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

2. The information disclosure statement filed 26 July 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because an English translation of the abstract has not been provided for the European reference 0 557 934 (please refer to line AP on the PTO 1449 form). It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Drawings

3. The drawings were received on 25 February 2004. These drawings are deemed acceptable for examination.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4-7, 12-13 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4-6, 12-13 and 17-19 recites the limitation "the access" in line 8 of claim 4 (line 5 of claim 5, line 3 of claim 6, line 14 of claim 12, line 3 of claim 13, and lines 15, 17 and 16 of claims 17, 18 and 19 respectively). There is insufficient antecedent basis for this limitation in the claim. More specifically, each of the base claims (referring to claim 1 for example) sets forth access "by said communicating means" (lines 9-10) and access "from an external apparatus" (lines 9-11). It is unclear in each of these claims which of these two accesses are being referenced by the phrase "the access". It is assumed that the phrase "the access" refers to the access from an external device.

Claim 7 is further rejected for inheriting the deficiencies of on claim 5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 5, 8-12, 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (US Patent 5, 378,887).

As for claims 1 and 9-11 Kobayashi teaches an information processing apparatus (method, medium and program) including an information recording medium, comprising:

communicating means for communicating data with said information recording medium (referring to Fig. 5, elements 32, 34 and 36 (and the data transfer paths associated with these three units) comprise the communication means; the memory can be written to, or read from via the memory control section, or the memory may be accessed (i.e. read) by the memory control section via the read area deciding section) – col. 7, line 62 through col. 8, line 11;

detecting means for detecting access to said information recording medium (Fig. 5, element 36 – the memory control section controls access to and from the memory, therefore it is capable of detecting when the memory is being accessed – col. 7, line 63 through col. 8, line 11);

determining means for determining whether a result of detection by said detecting means indicates access by said communicating means or access from

an external apparatus (access can occur from a write operation via the external device (referring to Fig. 5, the external device communicates with the IC card via the non contact terminal (40), to the modulating and demodulating section (38), to the memory control section (36) – col. 7, line 63 through col. 8, line 17).

Additionally, the access could be simply result from reading the memory via the read area deciding section - col. 7, line 63 through col. 8, line 11). Note the memory control section is capable of making a determination of where the access is coming from; and

access controlling means for controlling the access from said external apparatus when said determining means determines that the result of detection by said detecting means indicates the access from said external apparatus (col. 2, line 64 through col. 3, line 11 – the system will generate an inhibition signal to control access to the memory via the external device for a predetermined time. The control means can decide weather or not to permit access from the external device to the main circuit based on frequencies of access, by uses the information provided by the inhibition signal).

As for claims 12 and 17-19, Kobayashi teaches an information processing apparatus (method, medium and program) including an information recording medium, comprising:

communicating means for communicating data with said information recording medium (referring to Fig. 5, elements 32, 34 and 36 (and the data transfer paths associated with these three units) comprise the communication

means; the memory can be written to, or read from via the memory control section, or the memory may be accessed (i.e. read) by the memory control section via the read area deciding section) – col. 7, line 62 through col. 8, line 11;

detecting means for detecting access to said information recording medium (Fig. 5, element 36 – the memory control section controls access to and from the memory, therefore it is capable of detecting when the memory is being accessed – col. 7, line 63 through col. 8, line 11);

determining means for determining whether a result of detection by said detecting means indicates access by said communicating means or access from an external apparatus (access can occur from a write operation via the external device (referring to Fig. 5, the external device communicates with the IC card via the non contact terminal (40), to the modulating and demodulating section (38), to the memory control section (36) – col. 7, line 63 through col. 8, line 17).

Additionally, the access could be simply result from reading the memory via the read area deciding section - col. 7, line 63 through col. 8, line 11). Note the memory control section is capable of making a determination of where the access is coming from; and

informing means for, when said determining means determines that the result of detection by said detecting means indicates the access from said external apparatus, notifying the access (once the circuit completes operation based on the access from the external device, an operation inhibition signal is generated to notify the system that a recent access has occurred, and the no

additional access is to occur until the predetermined time elapses – col. 2, line 64 through col. 3, line 11).

As for claim 5, Kobayashi teaches informing means for, when said determining means determines that the result of detection by said detecting means indicates the access from said external apparatus, notifying the access (once the circuit completes operation based on the access from the external device, an operation inhibition signal is generated to notify the system that a recent access has occurred, and the no additional access is to occur until the predetermined time elapses – col. 2, line 64 through col. 3, line 11).

As for claims 8 and 16, Kobayashi teaches the information recording medium as being a non contact type IC (Kobayashi's invention is directed towards controlling a non contact type IC card (see abstract)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent 5, 378,887) as applied to claims 1 and 9 above, and in further view of Masaki et al. (US PG Publication 2002/0188852 A1), hereinafter Masaki.

As for claims 2 and 15, though Kobayashi teaches detecting access to his information processing apparatus, he fails to teach recording the access information as history information on a recording medium.

Masaki however teaches an illegal access monitoring device for an IC card, which is used to monitor access to the IC card (paragraph 0037, all lines). Note Masaki specifically refers to storing access information in the IC card (paragraph 0112, all lines).

As for claim 3, Kobayashi's system is designed such that the access controlling means refers to the inhibition signal, rather than stored access history information in order to control access from the external device. Again Masaki teaches monitoring access to the card, and storing access information in said card, which may be referred to a later time to determine if access should be granted or denied based on the stored access information (see the rejection of claim 2 above).

It would have been obvious to one of ordinary skill in the art at the time of the invention for Kobayashi to further include Masaki's illegal access monitoring device for an IC card to his own non-contact IC card. By doing so, Kobayashi would benefit by increasing the security and integrity of data stored within the card by preventing unauthorized access to the memory, and further mitigating the threat of reverse engineering as taught by Masaki in paragraph 0036, all lines.

8. Claims 6-7 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi (US Patent 5, 378,887) as applied to claims 1 and 9 above, and in further view of Hinker et al. (US Patent 6,351,845 B1), hereinafter Hinker.

As for claims 6-7 and 13-14, though Kobayashi teaches notifying access to the memory, he fails to teach notifying the system via a warning display, sound, light, or vibration. He further fails to teach changing the informing method based on access source as claimed by Applicant.

Hinker however teaches an apparatus for analyzing memory use in which the system visually notifies a user when particular types of memory access are occurring within the system (see abstract). More specifically, Hinker teaches the use of different colors to designate the specific type of memory access (i.e. red for a read operation, and green for a write operation) – col. 8, lines 33-35.

It would have been obvious to one of ordinary skill in the art at the time of the invention for Kobayashi to further include Hinker's apparatus for analyzing memory use to his own non-contact IC card. By doing so, Kobayashi would benefit by having a means of visually informing the user of his card as to how frequently the memory is being accessed, and which access type is taking place. This in turn will help the user understand data dependencies within the memory as taught by Hinker in col. 3, lines 4-9. This information, can in turn help a user to understand how the memory is being accessed, in order to help reduce the number of accesses, hence improving the memory's efficiency as taught by Hinker in col. 1, line 20-32.

Note that since Kobayashi's system uses the read area deciding section (Fig. 5, element 34) to read data from the memory, and utilizes a path from elements 40, 38, 36 (Fig. 5) to access the memory (32) from the external device, a read and write operation would come from a different source, just as claimed by Applicant.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Yamaguchi et al. (US PG Publication 2004/0015560 A1) teach an information providing method and device.

Arisawa et al. (US PG Publication 2004/0035930 A1) teach an IC chip and information processing terminal.

Nakabe et al. (US PG Publication 2003/0137887 A1) teach a memory card.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig E. Walter whose telephone number is (571) 272-8154. The examiner can normally be reached on 8:30a. - 5:00p M-F.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571) 272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

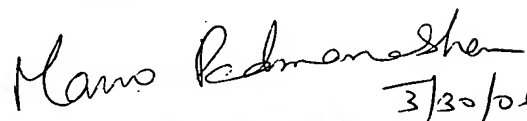
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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Craig E Walter
Examiner
Art Unit 2188

CEW



3/30/06

MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER